UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/347,311	07/02/99	PLAETINCK G	B0192/7010

HM22/0816

JOHN R VAN AMSTERDAM
C/O WOLF GREENFIELD & SACKS P C
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON MA 02210-2211

EXAMINER	
SHUKLA, R	
ART UNIT	**PAPER NUMBER**
1632	8

DATE MAILED: 08/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/347,311	Plaetinck et al
Examiner	**Group Art Unit**
Ram Shukla	1632

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____*one*_____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-91* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-91* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

1. Claims 1-91 are pending in the instant application.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-24, 38-48, 68-70, drawn to a method of identifying genes by producing a ds RNA in a cell, classified in class 800, subclass 3.

II. Claims 25-37, drawn to a method of making a transgenic organism by altering the expression of gene, using a dsRNA, classified in class 800, subclass 21.

III. Claims 49, 71 and 72, drawn to a plasmid pGN1 and an organism transformed with said plasmid, classified in class 800, subclass 21.

IV. Claim 50, drawn to a plasmid pGN100, classified in class 435, subclass 320.1.

V. Claims 54-59, drawn to a method of alleviating plant infestation by a pest, classified in class 800, subclass 278.

VI. Claims 51, 60-62 and 91, drawn to a yeast two hybrid plasmid and an expression vector, classified in class 435, subclass 320.1.

VII. Claims 52, 60-67 and 79-83, drawn to a plasmid, an expression vector and a method of identifying cellular transformation using said plasmid and expression vector, classified in class 435, subclass 320.1.

VIII. Claims 53, 60-67, and 79-83, drawn to a plasmid, an expression vector and a method of identifying cellular transformation using said plasmid and expression vector, classified in class 435, subclass 320.1.

IX. Claims 73-78 and 84, drawn to a method of introducing a DNA in an organism by feeding said organism a microorganism, classified in class 435, subclass 455.

X. Claims 85-90, drawn to a method of assigning function to a DNA sequence in a multicellular organisms by producing dsRNA in said multicellular organism, classified in class 800, subclass 3.

3. Claims 60-62 are generic to inventions of groups VI-VIII. Should any of these groups be elected, claims 60-62 will be examined to the extent they encompass the elected invention.

4. Claims 63-67 and 79-83 are generic to inventions of groups VII and VIII. Should any of these groups be elected, claims 63-67 and 79-83 will be examined to the extent they encompass the elected invention.

5. The inventions are distinct, each from the other because of the following reasons:

The inventions of the groups I, II, V, IX, and X are drawn to different methods comprising different steps and therefore are patentably distinct each from the other. For example, the inventions of both, groups I and X are drawn to methods of identifying DNA sequences that confer a certain phenotype to a cell or a multicellular organism respectively, however, they are patentably distinct because the invention of group I is drawn to the method carried out in a cell whereas the method of group X is carried out in a multicellular organism, and therefore, the steps of these methods would be different, for example, introduction of the DNA, mechanism of expression, site of expression etc. The invention of the group II is patentable distinct from that of groups I and X, because the method of group II is to make a transgenic animal, steps of which are different from those of the groups I and X, for example, the method of group II would require introduction of a transgene into the germ cells of an animal and all the cells of the transgenic animal would comprise the transgene. The invention of group V is drawn to a method of decreasing plant infestation by a pest and therefore its steps would be different from those of the method of groups I, X and II and furthermore, the vector used for introducing the DNA into the plant would have different sequence elements, such as promoter structure. The invention of group IX is drawn to a method of introducing DNA in an organism by feeding it a microorganism and therefore, is different from those of the inventions of the methods of groups I, II, V, and X because none of these methods involve introduction of DNA by feeding a microorganism. Accordingly, the inventions of the groups I, II, V, IX and X will require separate searches, for example, in the non-patent literature.

The inventions of the groups III, IV, VI, VII, and VIII are drawn to different plasmids and are patentably distinct each from the other because they have different sequence structure and have different structural components. For example, the plasmids of groups III, IV, and VI have

different sequence structures, disclosed in Seq ID No 1, 2, and 3-11. Furthermore, they also have different structural elements, such as promoters, selectable marker genes etc. Therefore the inventions of groups III, IV, VI, VII, and VIII will require separate searches, for example, in the non-patent literature and in the sequence database.

The inventions of the groups III, IV, VI, VII, and VIII are also patentably different each from the inventions of the groups I, II, V, IX and X because they are drawn to plasmids and expression vectors while the inventions of groups I, II, V, IX and X are drawn to different methods. While the methods of the groups I, II, V, IX and X can not be used for making the inventions of the groups III, IV, VI, VII, and VIII, the inventions of the groups III, IV, VI, VII, and VIII can be used for multiple purposes. In conclusion, the inventions of the groups I-X are patentably distinct each from the other and they would require separate searches, for example, in the non-patent literature.

6. Because these inventions are distinct for the reasons given above and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Thursday from 8:00 am to 5:30 pm and every other Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda, can be reached on (703) 305-6608. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Ram R. Shukla, Ph.D.

Scott D. Priebe

SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER